

### **REMARKS**

Claims 1 through 25 are pending in this application. Claims 3, 4, 17 and 19 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application. Claims 24 and 25 are newly added. The Applicant appreciates the Examiner's indication of allowance of claims 9 through 15 and the allowability of claims 4 through 7 and 19 through 21.

#### **I. SPECIFICATION**

The Examiner mentioned the informality of the singular word of "I" on page 4, line 2. The word was amended to plural as suggested by the Examiner.

#### **II. CLAIM REJECTIONS - 35 U.S.C. § 102**

Claims 1, 8, 16-18, 22-23 were rejected under 35 U.S.C. §102(b) as being anticipated by Dornier (U.S. Patent 5,646,535). The Applicant respectfully traverses.

No claim is anticipated under 35 U.S.C. §102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned in the **MPEP §2131**, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every

element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as complete detail as is contained in the patent claim. *Id.*, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

The Examiner stated that Dornier discloses a portable computer. However looking at Dornier in col. 2, lines 50-51, Dornier concerns a personal computer and not a portable computer. The description in col. 2, lines 50-51 refers to figure 1 which is clearly disclosing a desktop type personal computer and no disclosure of a portable computer. The present invention, on the other hand mentions in claim 1 and 16 for example, *operating states of the portable computer*. 35USC102 mandates that the identical invention be disclosed where each and every element must be disclosed as arranged in the claims. Therefore, since the present invention claims *portable computer* and Dornier discloses only a personal computer that is not a portable computer, Dornier does not anticipate the claims of the present invention.

Furthermore in amended claim 17, Dornier does not disclose *each power-on self-test code corresponding to a specific light emitting diode* among the plurality of light emitting diodes. Dornier for instance in col. 4, lines 21-41 states that certain on and off changes and combinations and certain colors at particular times display the particular group of tests. Therefore, a user will still have to know what combination of colors or sequence of lights in combination *etc.* will represent a certain

state. Therefore, even in Dornier as seen in the earlier POST cards, one still must decipher the code or sequence. Dornier does not disclose each POST corresponding to a specific indicator. The present invention on the other hand according to claim 17 has each power-on self-test code corresponding to a specific light emitting diode among the plurality of light emitting diodes, which makes it much easier to appreciate the state or error in the POST.

Therefore, respectfully, claims 1, 8, 16-18, 22-23 are not anticipated by Dornier.

### **III. REJECTION OF CLAIMS (35 U.S.C. § 103)**

Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dornier (U.S. Patent 5,646,535) in view of Kang (U.S. Patent 6,434,696). The Applicant respectfully traverses.

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references

when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The combination of references must teach or suggest all of the claimed references according to MPEP 706.02(j). The Examiner stated that Dornier teaches or suggest of a portable computer. However, Dornier only teaches or suggests of a personal computer which as seen by figure 1 is a desktop computer. Claims 2 and 3 of the present invention on the other hand claim a portable computer. Looking at Kang, there is only a mention of a personal computer (col. 3, line 66) with no further description of a portable computer. Even if Kang did teach or suggest a portable computer, there is still no teaching of a portable computer with the limitations of the present invention. The Federal Circuit has mentioned that “[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious.” *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (CCPA 1964). Therefore, looking at the combination references there is no teaching or suggestion of a portable computer that has the limitations of the claims.

The present application mentioned on page 3, lines 4-7 that generally POST cards are

plugged in desktop computers and on page 3, lines 8-13, "if a portable computer such as a laptop and notebook computer, the POST card is pugged in an extension slot coupled to a docking station." The docking station makes the portable computer no longer portable, but essentially a desktop computer. As seen in Dornier, the art is still disclosing the desktop style computers that are not portable.

Furthermore, in claim 3, the combination of Dornier and Kang does not teach or suggest *each power-on self-test code corresponding to a specific light emitting device* among the plurality of light emitting devices. As mentioned above, Dornier for instance in col. 4, lines 21-41 states that certain on and off changes and combinations and certain colors at particular times display the particular group of tests. Therefore, a user will still have to know what combination of colors or sequence of lights in combination *etc.* will represent a certain state. Therefore, even in Dornier as seen in the earlier POST cards, one still must decipher the code or sequence. Dornier does not disclose each POST corresponding to a specific indicator. The present invention on the other hand according to claim 3 has each power-on self-test code corresponding to a specific light emitting diode which makes it much easier to appreciate the state or error in the POST. Kang also makes no teaching or suggestion of each POST corresponding to a specific light emitting device among the plurality of light emitting devices.

Concerning claims 2 and 3, the Examiner mentioned that Kang teaches or suggests *a key input device coupled to said controller, said key input activating a display of power-on self-test codes on the indicating device in response to a key input signal from the key input device.* Looking

at Kang it is seen that in col. 1, lines 61-64 and col. 2, lines 4-8 as cited by the Examiner, the key starts the “warm boot” which then executes the BIOS codes for the POST. Kang is teaching of a key input for executing a reset of the machine and then the reset initiates the BIOS codes for post and *not activating a display of power-on self-test codes on the indicating device in response to a key input*. Kang is still not teaching or suggesting of activating the display but of the process.

The Examiner stated that the warm boot would allow the modification of Kang with Dornier because the warm boot forces the computer in a ready state more quickly. However, the warm boot also has other implications. Further, the combination is still not teaching of *activating a display of power-on self-test codes on the indicating device in response to a key input* but of rebooting the computer which would then after the reboot initiate a POST process. A display of the POST codes is not possible by the combination of references by just a key input, but a “warm boot” would be necessary and under certain conditions may not reach the POST process. Respectfully, as mentioned above in *In re Wood*, it is the teaching and not just the bodily incorporation of one reference into another that matters concerning obviousness. 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979).

Therefore, respectfully, claims 2 and 3 are not obvious with respect to the combination of references Dornier and Kang.

#### **IV. NEWLY ADDED CLAIMS**

The mentioned references such as Dornier and Kang also do not disclose under 35USC§102 or teach or suggest under 35USC§103 all of the claimed limitations of the newly added claims 24

and 25.

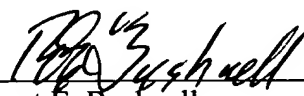
#### **V. ALLOWABLE SUBJECT MATTER**

The examiner stated that claims 4 through 7 and 19 through 21 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Following the advice of the examiner, claims 4 and 19 were rewritten in independent form including all of the limitation of the base claim and any intervening claims. Therefore, claims 4 through 7 and 19 through 21 should be allowable.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

A fee of \$372.00 is incurred by the addition of four (4) independent claims above three (3) and by the addition of two (2) claims above twenty-three (23) in this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

  
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Date: 3 July 2003  
I.D.: REB/SS